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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,457	06/28/2001	Kenichi Sameshima	010825	2154

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,457	SAMESHIMA ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-6 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' response and 1.132 declaration filed 6/8/05.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. 2,869,194) in view of Meyer (U.S. 4,264,760).

The rejection is adequately set forth in paragraph 7 of the office action mailed 3/6/04 and is incorporated here by reference.

Response to Arguments

4. Applicants' arguments regarding Gerber (U.S. 5,294,649) have been fully considered but they are moot in view of the discontinuation of the use of this reference against the present claims.

5. Applicants' arguments filed 6/8/05 have been fully considered but, with the exception of arguments relating to Gerber, they are not persuasive.

Specifically, in the office action mailed 12/9/04, the examiner argued that while Cooper discloses the use of filler in addition to resole and powdered magnesium oxide and while it is

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recognized that that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, Cooper was still applicable against the present claims and “consisting essentially of” was construed as equivalent to “comprising”. It was noted that the burden was on the applicant to show that the additional ingredients in the prior art, i.e. filler, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention. The examiner noted that applicants had not made such a showing.

In the response filed 6/8/05, applicants note that the fillers disclosed in Cooper are either neutral (sand, etc.) or weakly acidic (silica, etc.) and that the present claims exclude incorporation of fillers with such characteristics. Applicants note that if the fillers of Cooper were included in the present composition, the curing reaction would hardly occur.

However, while applicants argue that the fillers of Cooper would be excluded from the “consisting essentially of” claim language of the present claims, applicants provide no evidence to support their position. It is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by applicants regarding the filler of Cooper must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

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Applicants also argue that neither Cooper or Meyer disclose that the presently claimed ingredient (B), i.e. alkali earth metal oxide and/or alkali earth metal hydroxide, is incorporated into a composition containing resol phenol and ammonium thiosulfate.

However, col.1, lines 48-52, col.3, lines 53-63, col.5, lines 43-46, and Table 2 of Cooper disclose composition comprising both powdered magnesium oxide and resol phenol.

It is agreed that there is no disclosure in Cooper of ammonium thiosulfate which is why Cooper is used in combination with Meyer which teaches using ammonium thiosulfate with phenol-formaldehyde.

In light of the above, it is the examiner's position that the combination of Cooper with Meyer remains relevant against the present claims.

Allowable Subject Matter

6. Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7-9 would be allowable if rewritten in independent form given that there is no disclosure or suggestion in the "closest" prior art Copper (U.S. 2,869,194) or Meyer (U.S. 4,264,760) of method of curing resol phenol resin comprising resol phenol, alkali earth metal oxide and/or alkali earth metal hydroxide, and ammonium thiosulfate at a temperature of from 10-110 C as required in present claims 7-9.

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7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
8/12/05